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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,787	01/27/2004	Mary M. DaRif	6962D1	2596
7590 The Sherwin-Williams Company 11 Midland Bldg. - Legal Dept. 101 Prospect Avenue, N.W. Cleveland, OH 44115			EXAMINER VERAA, CHRISTOPHER	
			ART UNIT 3611	PAPER NUMBER
			MAIL DATE 09/15/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/765,787

Applicant(s)

DARIF ET AL.

Examiner

CHRISTOPHER E. VERA

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 in view of Nervig (US-3612292) and Teter et al. (US-6112665).

The applicant's admitted prior art in the specification page 1, lines 19-27 and page 2, lines 10-14 discloses the idea of placing paint chips within a rack and the idea of using paint chips with a plurality of color samples on a single card and the idea of covering a paint chip with a single color. The applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 does not disclose whether the display rack includes a wall which covers a chip section and the idea of placing perforations in the card to form a paint chip section. Nervig shows, in figure 1, a rack for displaying cards with a wall. In view of the teachings of Nervig, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 by placing paint color cards on a display rack as taught by Nervig, since Nervig includes dividers that can be adjusted

longitudinally and cannot be removed by unauthorized persons (Nervig, column 1, lines 55-58). Since it appears from a review of the pertinent drawings (figure 10 of the instant application and figure 1 of Nervig) that the applicant's drawings of a display rack are substantially identical to those of Nervig, it is clear that the structure, and in particular the wall, of Nervig is substantially the same as the structure being claimed by the applicant and would therefore be capable of covering and protecting chip sections from being grasped by a customer. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by the applicant (MPEP 2144, In re Lintner, 458 F.2d 1013, 173 USPQ 560). Teter et al. shows in figures 4 and 5 the idea of placing perforations (14) within a colored section in order to allow the perforated area to be removed. In view of the teachings of Teter et al. it would have been obvious to one in the art to modify the applicant's admitted prior art in the specification page 1, lines 19-27 and page 2, lines 10-14 by adding perforations to the color card to form a chip section since this would allow an opening to be formed within the color coated card which would allow better color matching to be performed, as taught by Teter et al., column 4, lines 55-65. In regard to claim 28, Teter et al. discloses the use of a plurality of tear lines, which would allow the chip section to be removed from the rest of the card. In regard to claim 29, the applicant discloses in the specification on page 1, lines 10-15 that the use of color cards having multiple colors on each card is known in the art and also discloses in the specification on page 1, lines 23-25 that it is known to place

these color cards into racks. It would have been obvious to one in the art to modify the applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 since this would allow a wider range of paint chip cards to be held and displayed in a single rack. Teter et al. discloses making the chip section small so the color swatches on the color strip would have a size greater in every direction than the chip section of the paint color card. In regard to claim 30, as best understood, the applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 in view of Nervig and Teter et al. does not disclose placing an unperforated space between the tear lines and including a fold line in the unperforated space. It would have been an obvious matter of design choice to modify applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 in view of Buschman and Teter et al. by making a space between the tear lines non-perforated since the applicant fails to define any advantage to making the space non-perforated and the perforated space defined by Teter et al. would work equally well. Further, the chip section taught by Teter et al. could be partially separated from the rest of the card and pivoted along the remaining attached perforated section.

Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 in view of Nervig (U.S. Patent No. 4,102,072) and Teter et al. (U.S.

Patent No. 6,112,665) as applied to claim 25 above and further in view of Edwards (U.S. Patent No. 4,992,050) or Goldsholl (U.S. Patent No. 3,224,113).

The applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 in view of Nervig and Teter et al. disclose the applicant's basic inventive concept except for placing a color coating on the back of each chip section. Edwards discloses in the abstract the idea of placing a first color of paint on a first side of a chip section and a coating of paint on the opposite side of each chip section. Edwards discloses that the paint on the second side has a different finish as compared to the first side. Goldsholl discloses in column 1, lines 59-62, the idea of placing paint on the front and back surfaces of a paint card. In view of the teachings of Edwards or Goldsholl it would have been obvious to one in the art to modify applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 by placing a coat of paint on the second surface of each chip section since this would allow more colors/finishes to be displayed by the color card. In regard to claim 26, it is considered within one skilled in art to place the same color on the back of each chip section as on the front since this would allow the color of the paint to be seen on either side of the chip section, i.e. easier and quicker to determine the paint color shown by the color card. In regard to claim 27, the colors on each side of the paint chip sections of Edwards are considered to be of the same color but would have different compositions. Further, as indicated above, placing a coat of paint on the second surface of each chip section would allow more colors to be

displayed by the card, i.e. one color on the front of the card and a second color on the back of the card. Also, when different finishes are used the colors would be slightly different.

Response to Arguments

Applicant's arguments filed 6/30/08 have been fully considered but they are not persuasive. The applicant argues that there is no prima facie case established since the examiner has not shown where all the claimed limitations are present in the prior art. In particular, the applicant argues that the necessity of the wall of the card rack covering the chip section is not taught. To the contrary, the examiner's rejection clearly shows that it would have been obvious to put the card taught by Teter et al, into the rack taught by Nervig, and that this combination would produce precisely that structural relationship, wherein the wall covers at least one of the chip sections. The applicant is not claiming a patentably new feature, but is merely appreciating an inherent feature of the prior art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER E. VERAA whose telephone number is (571)272-2329. The examiner can normally be reached on Monday through Friday, 8:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. E. V./

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Examiner, Art Unit 3611

/Paul N. Dickson/

Acting SPE of Art Unit 3611